

REMARKS

The Examiner issued an 8-way Restriction Requirement for the claims of the present application. The Restriction Requirement was as follows:

Invention I, claims 1-14, drawn to a method for formation of polyetherols, classified in Class 528, subclass 425;

Invention II, claims 15-27 drawn to a method for formation of polyetherols, classified in Class 528, subclass 425;

Invention III, claims 28-31, drawn to a method for formation of polyetherols, classified in Class 528, subclass 425;

Invention IV, claims 32-36, drawn to a method for formation of heteric polyetherols, classified in Class 528, subclass 425;

Invention V, claims 37-39, drawn to a method for formation of polyetherols, classified in Class 528, subclass 425;

Invention VI, claims 40-41, drawn to a method for formation of polyetherols, classified in Class 528, subclass 425;

Invention VII, claims 42-44, drawn to a method for formation of terminal cap modification of polyetherols, classified in Class 528, subclass 485; and

Invention VIII, claims 45-48, drawn to a method for formation of linear block copolymer polyetherols, classified in Class 525, subclass 88.

Applicants traverse the Restriction Requirement.

Invention I, claims 1-14, is generic to the inventions defined in claims 15-41. All the claims are methods for formation of polyetherols utilizing an aluminum phosphonate catalyst.

By the Examiner's own admission, Inventions I-VI have not acquired separate status within the art and in fact are all found in the same class and subclass, namely Class 528, subclass 425. Thus, it is unreasonable for the Examiner to place upon Applicants the burden of splitting these inventions out from each other. As discussed above, claim 1 is believed to be generic to independent claims 28, 32, 37 and 40. Independent claim 28 is identical to claim 1, except the alkylene oxide is recited as propylene oxide. Independent claim 32 is identical to claim 1 except the alkylene oxides are recited as a mixture of alkylene oxides. Independent claim 37 is identical to claim 1, except the alkylene oxide is recited as ethylene oxide. Independent claim 40 is identical to claim 1 except that it recites an oligomer as the initiator molecule. Applicants request that the Examiner consider combining Inventions I through VI into a single invention grouping. Applicants will be willing to consider withdrawing Inventions VII (claims 42-44) and Invention VIII (claims 45-48). Applicants believe it would not be an undo burden on the Examiner, as the claims relating to Inventions I through VI are all found in the same class and subclass, to treat claims 1-41 as a single inventive group.

The Examiner additionally objected to the Specification stating that "polyetherols in the Title and elsewhere in the Specification is not recognized as chemical term". The Examiner furthermore rejected claims 1, 15, 28, 32, 34, 36, 37, 39, 40 and 42-45 under 35 U.S.C. § 112, first paragraph for the reasons set forth in the objection to the Specification. Finally, the Examiner rejected claim 32 additionally under 35 U.S.C. § 112, first paragraph, stating "the term 'heteric' is not recognized as chemical term."

As the Examiner is no doubt aware, the patentee is allowed to be his own lexicographer.

Provided a term is not used in a manner inconsistent with that in the art, it is not necessary for

H&H 65,205-117

Serial No. 10/037,958

the Applicant to set out separately a definition of each and every term. With respect to the present rejection, the term "polyetherol" is well known by those of ordinary skill in the art to refer to a polyether polyol. A simple search on the internet using Google.com reveals a listing of over 50 web sites utilizing this term as is known to those of ordinary skill in the art. The term is utilized in chemical texts, on the Assignee's web site, sections of the Federal Register, and many other places. It is well known and obvious from the description in the present Specification and the language of the claims that the term polyetherol is being utilized to describe a polyether polyol formed by an alkoxylation reaction of an initiator molecule with alkylene oxides as is well known in the art. Therefore, Applicants suggest that the term is recognized as a chemical term in the art and do not believe that it is necessary that the term be changed in the specification or the claims.

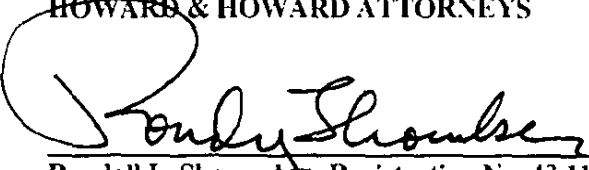
Likewise, in the art of polyether polyols, it is well known that the term "heteric" refers to a portion of a polyol formed by carrying out the alkoxylation reaction with a mixture of two or more alkylene oxides (i.e., a heterogeneous mixture of alkylene oxide monomers). One of ordinary skill in the art reading claim 32 would instantly recognize that the term "heteric" is being used to describe a polyether polyol formed in an alkoxylation reaction using a mixture of alkylene oxide monomers. Therefore, Applicants believe that the term is not indefinite and do not believe that it is necessary that it be amended.

Applicant's attorney respectfully submits that the claims as amended are now in condition for allowance and respectfully requests such allowance.

Respectfully submitted,

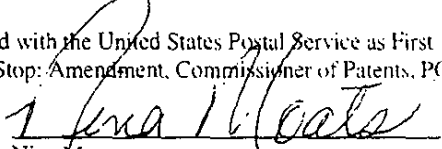
HOWARD & HOWARD ATTORNEYS

Date *August 11, 2003*


Randall L. Shoemaker, Registration No. 43,118
Howard and Howard Attorneys, P.C.
The Pinehurst Office Center, Suite 101
39400 Woodward Ave.
Bloomfield Hills, MI 48304-5151
(248) 723-0425

CERTIFICATE OF MAILING

I hereby certify that this paper or fee is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Stop: Amendment, Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450, on August 11, 2003.


Nina Moats